

**REMARKS**

Claims 1-4 are pending.

**Claim Rejections under 35 USC §102**

**Claim 1 is rejected under 35 USC §102(e) as being anticipated by Tyberg et al. (U.S. Patent No. 6,270,726).**

In rejecting the claimed invention, the outstanding Office action has specifically stated that:

“the examiner asserts that the diameter of the probe is not too wide to fit in the vessel disclosed in Figures 3B and 3C of the Tyberg reference. The probe can be clearly seen in the Figures as being inserted into a vessel and contacting the lowermost portion of the vessel.”

The Applicant respectfully disagrees with the Office assertion that the probe can make a contact with the lowermost portion of the vessel.

As clearly seen in Figures 3A-3C of Tyberg, the pipetting tip 36 can never reach a lowest position of the inner wall surface of a vessel, because the diameter of the pipetting probe is too wide relative to the diameter of the vessel. It should be noted that the bottom of the tube shown in Fig. 3B has a curvature. A lowest position of the inner wall surface vessel is clearly shown to be in the middle of the curvature. From the dimensions shown in Figures 3B -3C, pipetting tip 36 can never reach the lowest position of the inner wall surface vessel. Even if pipetting tip 36 can come into contact with the lowest position of the inner wall, which it cannot, side wall of pipetting probe 34 would inevitably come in contact with the inner wall of the vessel. This may cause breakage of either the pipetting probe 34 or the vessel as they are both typically made of glass.

In contradistinction, as clearly seen by way of an example in Figures 5B-5C of the present invention, the diameter of the suction nozzle 2 is proportionally many times smaller than the

U.S. Patent Application Serial No.: 09/875,184  
Attorney Docket No. 010493

widest portion of the diameter of the vessel 6a. This would permit the distal end 2A to be in contact with the lowest position of the inner wall surface 6b of vessel 6, yet without causing sidewalls of suction nozzle 2 and vessel 6 to come in contact with each other. Hence, there would not be a danger of glass breakage. A clear advantage of having the distal end 2A to be in contact with the lowest position of the inner wall surface 6b is to minimize wastage of any liquid sample as shown in Fig. 5C of the present invention.

Again, to ensure this distinction is accurately reflected in claim 1, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof to come in contact with a lowest position of the inner wall surface of the vessel yet without having a sidewall of the suction nozzle to come into contact with a sidewall of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.” These features are not disclosed in the asserted prior art. By so amending, independent claim 1 is further patentably distinguished over the asserted prior art. All claims dependent thereon, by virtue of inherency, are also further patentably distinguished over the asserted prior art.

Reconsideration and withdrawal of this rejection are respectfully requested.

**Claim 2 is rejected under 35 USC §102(b) as being anticipated by Yu (U.S. Patent No. 5,779,907).**

Regarding making a *prima facie* case of equivalence for a means plus function claim, MPEP 2183 has specifically stated that:

“the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent. Factors that will support a conclusion that the prior art element is an equivalent are:

(A) the prior art element performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification....

(B) a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element disclosed in the specification....

(C) there are insubstantial differences between the prior art element and the corresponding element disclosed in the specification....

(D) the prior art element is a structural equivalent of the corresponding element disclosed in the specification....”

Regarding the issue whether Yu discloses an equivalent of the corresponding structure, material or acts of the claimed “magnet moving means for supporting the magnets”, the answer is no, because other than showing a box with a label of elevator mechanism 55, and a box with a label of elevator 65 in the asserted prior art, no details of the elevator mechanism 55 and no details of the elevators 65 are disclosed. Therefore, there are no bases to compare the claimed invention with Yu so as to ascertain whether either one of the above identified elements (A), (B), (C) and (D) are satisfied.

For the foregoing reasons, a *prima facie* case to prove that there is an equivalent of “magnet moving means for supporting the magnet” of claim 2 in the asserted prior art is simply not met.

**Claim 2 is rejected under 35 USC §102(b) as being anticipated by Wilks (U.S. Patent No. 5,578,495).**

Independent claim 2 has positively recited “magnetic moving means for supporting the

magnet so as to be moveable toward and away from the vessel.” This claimed language is supported by way of an example in Figures 4A and 4C, wherein there is indeed a magnetic moving means (4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j) for supporting the magnet 8 so as to be moveable toward and away from the vessel 6. More specifically, in Figure 4A, magnet 8 is shown to be separately below microplate assembly 6. In Figure 4C, magnet 8 is shown to be on the same level as microplate assembly 6.

It is well settled that:

“[t]he plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. … Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson*, 29 USPQ2d 1845, 1848-1850 (Fed. Cir. 1994).

In rejecting the above-enumerated claims, the Office has failed to interpret the claimed language in light of the corresponding structure, material, or acts described therein the specification, and find the same specification or equivalents thereof in the applied prior art of record. Had the Office interpreted the claimed invention in view of *In re Donaldson*, the Office would have readily seen that the above-explained feature patentably distinguishes the claimed invention over the applied prior art of record. Therefore, the Office has not met the requirements of *In re Donaldson*. Consequently, the Office has not met its burden of proving an anticipation rejection.

More specifically, the only magnets disclosed in Wilks are magnetic element 225 and magnetic stir bar 258. How these magnets move are shown in Figure 4 and explained in associated

written description. From comparing the differences in structure, material and acts of Wilks and that of the claimed invention as shown by way of examples in Figures 4A and 4C, it is apparent that they do not satisfy any one of the four elements (A), (B), (C) and (D) as stated in MPEP 2183 to establish a *prima facie* case of equivalence for a means plus function claim.

For the foregoing reasons, a *prima facie* case to prove that there is an equivalent of "magnet moving means for supporting the magnet" of claim 2 is simply not met.

Reconsideration and withdrawal of this rejection are respectfully requested.

### Claim Rejections under 35 USC §103

**Claim 3 is rejected under 35 USC §103(a) as being unpatentable over Schultz *et al.* or in the alternative in view of Ade *et al.* (U.S. 5,853,665).**

Independent claim 3 has been amended to recite "wherein the buffer tank has two ports, one port is connected to the suction pump and another port is connected to a switching valve."

These features are shown by way of an example in Figure 1, wherein the buffer tank 5h indeed has two ports, one port is connected to the suction pump 5c and another port is connected to the switching valve 5d . The advantage of having two ports is to provide more controls over flow rates and flow characteristics of fluid samples. This added control provides better fine-tuning over flow rates and fluid flow characteristics of different fluid samples with different viscosities.

As clearly shown in Figure 1 of Schultz, hydraulic solution source 50 has only one port being connected to pump 12. Therefore, independent claim 1, as newly amended, is patentably distinguished over the asserted prior art.

Reconsideration and withdrawal of this rejection are respectfully requested.

**Claims 1-4 are rejected under 35 USC §103(a) as being unpatentable over Schultz *et al.* in view of Ade *et al.* as applied to claim 3 above, and further in view of Tyberg and Yu.**

Regarding claim 1, as clearly shown by way of an example in Figures 5B-5C of the present invention, the distal end 2A of the suction nozzle 2 is in contact with the inner wall surface 6b of the vessel while suction is being performed. Furthermore, the distal end 2A is located at a lowest position of the inner wall surface 6b of the vessel. Allowing distal end 2A to reach a lowest position of inner wall surface 6b of the vessel would minimize wastage of fluid samples.

Also as clearly shown by way of an example in Figures 5B-5C of the present invention, the diameter of the suction nozzle 2 is proportionally many times smaller than the widest portion of the diameter of the vessel 6a. This would permit the distal end 2A to be in contact with the lowest position of the inner wall surface 6b of a vessel 6.

To ensure these differentiations are accurately reflected in independent claim 1, the claim language has been amended to include “the suction nozzle moving means being capable of positioning the suction nozzle with the distal end thereof come in contact with a lowest position of the inner wall surface of the vessel yet without having a sidewall of the suction nozzle to come in contact with a sidewall of the vessel; wherein suction is performed while the distal end is in contact with the lowest position of the inner wall surface of the vessel.” These patentably distinguishing features are not disclosed or taught in the asserted prior art references.

Regarding claim 3, a further feature that the buffer tank has two ports, one port is connected to the suction pump and another port is connected to a switching valve. These features are not disclosed or taught in the asserted prior art.

Independent claims 3 and 4 have positively recited “magnetic moving means for supporting

the magnet so as to be moveable toward and away from the vessel.” This claimed language is supported by way of an example in Figures 4A and 4C of the present invention, wherein there is indeed a magnetic moving means (4a, 4b, 4c, 4d, 4e, 4f, 4g, 4h, 4i, 4j) for supporting the magnet 8 so as to be moveable toward and away from the vessel 6. More specifically, in Figure 4A of the present invention, magnet 8 is shown to be separately below microplate assembly 6. In Figure 4C of the present invention, magnet 8 is shown to be on the same level as microplate assembly 6.

It is well settled that:

“[t]he plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. … Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” *In re Donaldson*, 29 USPQ2d 1845, 1848-1850 (Fed. Cir. 1994).

In rejecting the above-enumerated claims, the Office has failed to interpret the claimed language in light of the corresponding structure, material, or acts described therein the specification, and find the same specification or equivalents thereof in the applied prior art of record. Had the Office interpreted the claimed invention in view of *In re Donaldson*, the Office would have readily seen that the above-explained feature patentably distinguishes the claimed invention over the applied prior art of record. Therefore, the Office has not met the requirements of *In re Donaldson*. Consequently, the Office has not met its burden of proving an obviousness rejection.

As this is a three way combination rejection including three prior art references, it should be noted that a valid obviousness rejection is not formulated by choosing and picking from the

prior art whatever parts called for in a claim and combine the prior art together to conclude that the combination is obvious. Otherwise, all claims can be rejected by a parts catalog. Section 2143 of the MPEP has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

Therefore, should the Office either be unable to identify each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

U.S. Patent Application Serial No.: 09/875,184  
Attorney Docket No. 010493

**Prior Art Indicated To Be Pertinent To The Disclosure**

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

U.S. Patent Application Serial No.: 09/875,184  
Attorney Docket No. 010493

**CONCLUSION**

In view of the aforementioned amendments and accompanying remarks, all pending claims are believed to be in condition for allowance, which action, at an early date, is requested.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

By:   
Michael N. Lau  
Reg. No.: 39,479  
Attorney for Applicants  
Tel: (202) 822-1100  
Fax: (202) 822-1111

MNL/eg/asc/rer